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10/765,106	01/28/2004	Richard D. Ferris	FERR-004	9707
21884	7590	01/11/2006		
WELSH & FLAXMAN LLC 2000 DUKE STREET, SUITE 100 ALEXANDRIA, VA 22314			EXAMINER BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 01/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/765,106

Applicant(s)

FERRIS, RICHARD D.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,723,001. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of U.S. Patent No. 6,723,001 have the ratio of the width to the length and a club being a putter as the only differences. The ratio is the feature which made claims 1-5 of U.S. Patent No. 6,723,001 allowable. As such it would be obvious to remove this element of structure since all ovals with have a ratio of width to length and now the claims do not require it. Claims 1-2 of this application contain all the elements of structure which were claimed in claims 1, and 4-5 of patent 6,723,001.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cacicedo in view of Bloom, Radakovich and Takeuchi.

Cacicedo discloses a hand grip having an oval shape with a front edge having a larger radius than a rear edge (Fig. 10), an upper edge and a lower edge (Fig. 17), an oval cross section shape along substantially the entire handle between an upper and lower edge (Fig. 17), and a grip cap having no vent hole (Fig. 13) in order to establish a stiffness and feel to a hand grip (Abstract).

Cacicedo lacks a putter, an oval cross section shape along the entire handle between an upper and lower edge, a length dimension being perpendicular to a first plane of a ball striking face, alignment indicia on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and a first alignment line and second alignment line intersecting to form four angles and a cross.

Bloom discloses a putter (Fig. 4), an elongated axis of an oval, cross-sectional shape having a length being perpendicular to the plane of the ball striking face (Abstract), and an oval cross section shape along the entire handle between an upper and lower edge in order to have an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement (Abstract). In view of the patent of Bloom it would have been obvious to modify the club of Cacicedo to include a putter in order to utilize the advantages of establishing a stiffness and feel to a handgrip for a putter. In addition, in view of the patent of Bloom it would have been obvious to modify the club of Cacicedo to have an elongated axis of an oval along the entire handle between an upper and lower edge, cross-sectional shape having a length being perpendicular to the plane of the ball striking face in order to promote a preferred palm and promotes proper hand and body placement along the handle and in order to have the same feel along the entire length of a grip.

Radakovich discloses a sighting device placed on a flat surface of a grip end (Figs. 4-5) having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line (Ref. Nos. 92, 48, Fig. 5) in a direction perpendicular to a first plane of a ball striking face, a second alignment line (Ref. No. 94 in figure 4 and the boundary line for figure 5) being perpendicular to a first alignment line, parallel to a ball striking face (Fig. 5, Col. 5, Lns. 26-39), indicia on flat surface in the form of indicia on a sticker which is placed on a butt end of a grip, a design of an arrow may be varied (Fig. 5, Col. 5, Lns. 27-33) in order to improve accuracy (Col. 1, Lns. 7-10) by improving alignment and control of a face (Col.

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1, Lns. 35-37), and a grip able to be used with a putter. Takeuchi discloses alignment lines for grip positioning on a shaft being on a flat surface of a grip and being indicia (Fig. 5, Col. 4, Lns. 11-16) filling up the entire length and width of a grip top flat surface except the center (Fig. 5). In view of the patent of Radakovich it would have been obvious to modify the putter of Cacicedo to have a sighting device placed on a flat surface of a grip end having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line in order to assist a golfer in improving accuracy by improving alignment and control of a face of a club. In view of the patent of Radakovich and Takeuchi it would have been obvious to modify the putter of Cacicedo to have the alignment lines being indicia and taking up the entire length, width and center of a grip top flat surface and a first alignment line and second alignment line intersecting to form four angles and a cross in order to minimize the number of parts needed for a grip by having indicia and in order to be more visually visible for a golfer by using the entire surface for the alignment indicia. As such for an oval shaped grip a first alignment line will be longer than a second alignment line.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cacicedo in view of Bloom, Radakovich and Takeuchi as applied to claims 1-2 and 4-5 above, and further in view of Eberle or Dishner.

Cacicedo lacks a handle extending at least half of the overall length of the club from the head to the upper end of a shaft. Eberle discloses an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), an elongated axis of an oval, cross-sectional shape being perpendicular to the plane of the ball striking face (Col. 3, Lns. 55-57), and a handle having a length approximately half the overall length of the golf club (Fig. 1) in order to have a pendulum type putter (Col. 1, Lns. 7-32). Dishner discloses an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), and a handle having a length approximately half the overall length of the golf club (Figs. 5-6) in order to have a length adaptable to a wide variance of personal stances and physiognomy (Col. 4, Lns. 13-14). In view of the patents of Eberle or Dishner it would have been obvious to modify the putter of Cacicedo to have a handle extending at least half of the overall length of the club from the head to the upper end of a shaft in order to be able to modify the stiffness and feel for a handle of a pendulum type putter and to have a length adaptable to a wide variance of personal stances and physiognomy.

6. Claims 6-7, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloom in view of Radakovich and Takeuchi.

Bloom discloses a putter (Fig. 4), an elongated axis of an oval, cross-sectional shape having a length being perpendicular to the plane of the ball striking face (Abstract), and an oval cross section shape along the entire handle between an upper

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and lower edge in order to have an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement (Abstract).

Boom lacks an alignment indicia on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line.

Radakovich discloses a sighting device placed on a flat surface of a grip end (Figs. 4-5) having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line (Ref. Nos. 92, 48, Fig. 5) in a direction perpendicular to a first plane of a ball striking face, a second alignment line (Ref. No. 94 in figure 4 and the boundary line for figure 5) being perpendicular to a first alignment line, parallel to a ball striking face (Fig. 5, Col. 5, Lns. 26-39), indicia on flat surface in the form of indicia on a sticker which is placed on a butt end of a grip, a design of an arrow may be varied (Fig. 5, Col. 5, Lns. 27-33) in order to improve accuracy (Col. 1, Lns. 7-10) by improving alignment and control of a face (Col. 1, Lns. 35-37), and a grip able to be used with a putter. Takeuchi discloses alignment lines for grip positioning on a shaft being on a flat surface of a grip and being indicia (Fig. 5, Col. 4, Lns. 11-16) filling up the entire length and width of a grip top flat surface except the center (Fig. 5). In view of the patent of Radakovich it would have been obvious to modify the putter of Bloom to have a sighting device placed on a flat surface of a grip end having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line in a



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direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line in order to assist a golfer in improving accuracy by improving alignment and control of a face of a club. In view of the patent of Radakovich and Takeuchi it would have been obvious to modify the putter of Bloom to have the alignment lines being indicia and taking up the entire length, width and center of a grip top flat surface and a first alignment line and second alignment line intersecting to form four angles and a cross in order to minimize the number of parts needed for a grip by having indicia and in order to be more visually visible for a golfer by using the entire surface for the alignment indicia. As such for an oval shaped grip a first alignment line will be longer than a second alignment line.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boom in view of Radakovich and Takeuchi as applied to claims 6-7, and 9-10 above, and further in view of Eberle or Dishner.

Boom lacks a handle extending at least half of the overall length of the club from the head to the upper end of a shaft. Eberle discloses an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), an elongated axis of an oval, cross-sectional shape being perpendicular to the plane of the ball striking face (Col. 3, Lns. 55-57), and a handle having a length approximately half the overall length of the golf club (Fig. 1) in order to have a pendulum type putter (Col. 1, Lns. 7-32). Dishner discloses an elongated handle having a generally oval, cross-

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sectional shape including rounded front and rear edges (Fig. 3), and a handle having a length approximately half the overall length of the golf club (Figs. 5-6) in order to have a length adaptable to a wide variance of personal stances and physiognomy (Col. 4, Lns. 13-14). In view of the patents of Eberle or Dishner it would have been obvious to modify the putter of Boom to have a handle extending at least half of the overall length of the club from the head to the upper end of a shaft in order to have a length adaptable to a wide variance of personal stances and physiognomy.

8. Claims 11-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radakovich in view of Takeuchi.

Radakovich discloses a sighting device placed on a flat surface of a grip end (Figs. 4-5) having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line (Ref. Nos. 92, 48, Fig. 5) in a direction perpendicular to a first plane of a ball striking face, a second alignment line (Ref. No. 94 in figure 4 and the boundary line for figure 5) being perpendicular to a first alignment line, parallel to a ball striking face (Fig. 5, Col. 5, Lns. 26-39), indicia on flat surface in the form of indicia on a sticker which is placed on a butt end of a grip, a design of an arrow may be varied (Fig. 5, Col. 5, Lns. 27-33) in order to improve accuracy (Col. 1, Lns. 7-10) by improving alignment and control of a face (Col. 1, Lns. 35-37), and a grip able to be used with a putter.

Radakovich lacks a first alignment line and second alignment line intersecting to form four angles and a cross.

Takeuchi discloses alignment lines for grip positioning on a shaft being on a flat surface of a grip and being indicia (Fig. 5, Col. 4, Lns. 11-16) filling up the entire length and width of a grip top flat surface except the center (Fig. 5). In view of the patent of Takeuchi it would have been obvious to modify the club of Radakovich to have the alignment lines being on both sides of the end of a grip with indicia taking up the entire length, width and center of a grip top flat surface forming a cross and four angles in order for the alignment lines to be more visually visible for a golfer by using the entire surface for the alignment indicia.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Radakovich in view of Takeuchi as applied to claims 11-12 and 15 above, and further in view of Eberle or Dishner.

Radakovich lacks a handle extending at least half of the overall length of the club from the head to the upper end of a shaft. Eberle discloses a handle having a length approximately half the overall length of the golf club (Fig. 1) in order to have a pendulum type putter (Col. 1, Lns. 7-32). Dishner discloses a handle having a length approximately half the overall length of the golf club (Figs. 5-6) in order to have a length adaptable to a wide variance of personal stances and physiognomy (Col. 4, Lns. 13-14). In view of the patents of Eberle or Dishner it would have been obvious to modify the club of Radakovich to have a handle extending at least half of the overall length of the club from the head to the upper end of a shaft in order to have a length adaptable to a wide variance of personal stances and physiognomy.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Radakovich in view of Takeuchi as applied to claims 11-12 and 15 above, and further in view of Boom.

Radakovich lacks a first alignment line being longer than a second alignment line.

Bloom discloses a putter (Fig. 4) with a cross section of a grip being oval with a major axis perpendicular to the face of head in order to have an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement (Abstract). In view of the patent of Bloom it would have been obvious to modify the putter of Radakovich to have a grip being an oval with a major axis perpendicular to the face of a head with the first alignment line along the major axis and the second alignment line along the minor axis in order to have a grip to having an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement as well as alignment features a golfer is able to use when hitting a ball.

### ***Response to Arguments***

11. The argument that double patenting rejection is improper due to the limitations of the claims of this application are patentably distinct over the shape as claimed in the claims of patent 6,723,001 is disagreed with. All the structure claimed in the combination of claims 1-2 of this application is contained in the combination of claims 1

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and 4-5 of patent 6,723,001. The applicant commented on the examiner using both figures 4 and 5 in the rejection causing confusion. The examiner was merely pointing out that both of these embodiments show alignment lines which are perpendicular to one another and being used for alignment purposes. Either of these embodiments coupled with the teaching of Takeuchi the examiner believes would result in the applicant's alignment lines which produce four corners. The argument that it is improper to use the reference of Radakovich since Radakovich does not have alignment lines with form four angles or a cross is disagreed with. Radakovich was not used alone to argue that it would be obvious to have this structure but Radakovich was combined with Takeuchi which shows alignment lines on both halves of a grip end for alignment purposes. Takeuchi would not need to have alignment lines on both halves to perform alignment of a grip on a club. However Takeuchi did teach having alignment lines on both halves of a grip. This same teaching would be obvious to add to the alignment device of Radakovich to further aid the golfer in aligning a club when playing. The argument that having a cross with the alignment lines of Radakovich would destroy the reference of Radakovich is disagreed with. It would enhance the objective of Radakovich. Many heads have alignment lines which are rearward of a impact area and are effective in being used by a player to align a club in the target direction. The importance is that the line is aligned in the direction of the target. The argument that the reference of Radakovich is improper in that if a sticker is used it would need to be 3 – dimensional and tilted is disagreed with. Radakovich discloses alignment devices which are not tilted (Fig. 10, Col. 2, Lns. 62-63) and clearly Radakovich does not discuss a

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sticker embodiment (Col. 5, Lns. 27-33) having a tilting feature associated with when attached to a butt end of a shaft. One skilled in the art would clearly see this as adding a thin sticker with alignment indicia to a flat face of a butt end of a club. The argument that combining the references of Radakovich in view of Takeuchi is improper due to neither references disclosing intersecting lines is disagreed with. One of the definitions of intersect is to have one or more points in common (The Random House College Dictionary Revised Edition 1975). Clearly Radakovich's alignment lines meet this definition of intersection in a "T" shaped intersection. The argument that neither references disclose intersecting lines as indicia is disagreed with. Radakovich clearly states that a sticker is able to also be used (Col. 5, Lns. 30-33). Clearly if a sticker is used having intersecting alignment lines as shown in figures 4 or 5 indicia would have be used. The argument that it is improper to use the reference of Radakovich since placing indicia lines statically affixed to a butt end would make the device inoperative is disagreed with. Clearly placing a sticker on a butt end of a club is statically affixing the alignment device to a butt end. Plus if the first alignment line is aligned to be perpendicular to a face some golfers would want it to be a permanent alignment device since golfer's mostly attempt to hit a ball square when playing a round of golf (Col. 5, Lns. 34-39).

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

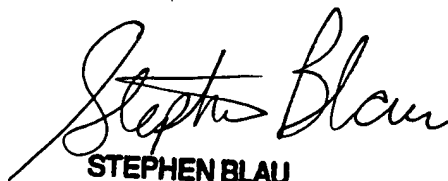
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Slb/ 7 January 2006



**STEPHEN BLAU**  
**PRIMARY EXAMINER**